

Applic. No. 10/010,246  
Response Dated August 20, 2007  
Responsive to Final Office Action of January 5, 2005

Remarks:

Claims 1 to 10 and 17, 18, and 21 to 32 are now in the application. Claims 3, 7 to 9, 18, 24, 28, and 29 have been amended. Claims 11 to 16 and 19 to 20 were canceled in a previous amendment to facilitate prosecution of the instant application. Claim 32 has been added.

1. Answer to New Ground of Rejection Reopens Prosecution

It is initially noted that, in the Examiner's Answer, a *new ground for rejection* was entered. See pages 6 to 7 and 14 thereof. Because of this, applicants have the ability to either maintain the appeal or reopen prosecution. Applicants respectfully believe that the new ground for rejection cannot be maintained because the dependent claims are all supported in the specification as set forth below. Regardless, applicants have amended some of the dependent claims for clarity purposes only. It is believed that the amendments made merely restate what already was present therein. Because of these amendments, applicants respectfully request that the appeal be withdrawn and that prosecution be reopened.

Applicants have also added a new independent claim 32, which is supported in the specification as originally submitted. The addition of this new claim is proper because of the appeal withdrawal and the reopening of prosecution.

Finally, on June 29, 2007, applicants filed a Supplemental Information Disclosure Statement. Due to the reopening of prosecution, these references must be entered and included in the Examiner's consideration of the claims.

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2. Claims 3, 7 to 10, 18, 24, and 28 to 31 Comply with the Section 112 Requirement of Enablement.

It is respectfully believed that the Section 112 rejection is incorrect and should be withdrawn. On pages 6 to 7 and 12 to 13, the Examiner first contends that there is no support for the "two deformable retainers" feature in claims 3, 7 to 10, 24, and 28 to 31. The Examiner, however, fails to compare FIGS. 19, 20, 21, 22, 23, and 24 and the associated text on page 9 of the specification with these claims. Clearly, the specification discloses and describes in detail two retainers 320, 322 and 420, 422. Each of these two retainers 320, 322, 420, 422 deform.

More specifically, claim 1 first introduces "*at least one* deformable retainer extending past one end of said arms." (Emphasis added by applicants.) This means that there exists at least one retainer. There could be any amount more, but there must be at least one. Claim 3 in contrast indicates that "*said at least one* deformable retainer" is "*two* deformable retainers, one extending from each of said arms." (Emphasis added by applicants.) Under the Doctrine of Claim Differentiation, this clearly indicates that the "at least one" in claim 1 is being changed and expanded to be "two" with one of the retainers extending from the "first arm" and the other retainer extending from the "second arm." In spite of this clear claim language, however, the Examiner is somehow interpreting this as having one retainer on one arm being two retainers *on one arm*. Applicants respectfully believe that this strained interpretation is incorrect and is not supportable because of the existence of the phrase "one extending from each of said arms" in the claim. The Examiner also applies this rejection to claims 7, 24, and 28 but the rejection is

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equally incorrect for the same reason. Apparently, the Examiner does not prefer the way that applicants have worded this feature. Thus, in an effort to even more clearly define this feature, applicants have amended claims 3, 7, 24, and 28 to provide that "said at least one deformable retainer is a pair of deformable retainers, one extending from each of said first and second arms." Emphasis supplied by applicants. Applicants have also clarified claims 8, 9, 29, and 30 to change "said retainers are ..." to "each of said retainers is ...".

As is clearly understood, these changes are not substantive in any way and only change the grammar of the respective claims in an effort to meet the Examiner's preference for claim drafting. Thus, these changes in no way narrow the dependent claims for any reason related to patentability and, therefore, retain all equivalents thereof.

Second, the Examiner contends that there is no support for the "plurality of surgical clips" feature of claim 18. It is respectfully noted that the instant application incorporates by reference co-owned application Serial No. 10/010,908, corresponding to U.S. Patent Publication No. 2002/0198537. Not only does this incorporated text show, disclose, and enable a plurality of clips (see, e.g., FIGS. 11, 17, 18, 19, 20), but the instant application further discloses the applier having a plurality of clips on page 17 of the instant specification as well as on page 18, lines 22 to 24. The process for delivering multiple clips is described in detail on page 21, for example, and other instances of "clips" are replete in the specification.

Like the rejection mentioned immediately above, claim 17 first introduces "*at least one surgical clip*." (Emphasis added by applicants.) This means that there exists "at least one" clip in the kit

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disclosed in claim 17. There could be any amount more, but there must be at least one. Claim 18 in contrast indicates that "said *at least one* surgical clip" is "*a plurality* of surgical clips." (Emphasis added by applicants.) Under the Doctrine of Claim Differentiation, this clearly indicates that the "at least one" in claim 17 is being changed and expanded to be "a plurality" in claim 18. In spite of this clear claim language, however, the Examiner is twisting the language impermissibly and interpreting this as something else which is not understood by applicants. The Examiner indicates that "the appellant could have recited the 'kit comprising a plurality of clips'" but this is exactly what is claimed in claim 18. Apparently, the Examiner does not prefer the way that applicants have worded this feature. Thus, in an effort to even more clearly define this feature, applicants have amended claim 18 to provide that "said at least one surgical clip is a plurality of surgical clips." (Emphasis supplied by applicants.)

As is clearly understood, this change is not substantive in any way and only alters the grammar of the claim in an effort to meet the Examiner's preference for claim drafting. Thus, this change in no way narrow the dependent claim for any reason related to patentability and, therefore, retains all equivalents thereof.

For all of the above reasons, applicants respectfully request withdrawal of the Section 112 rejection.

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3. Claims 1, 2, 4, 5, 7, and 21 to 26 are Not Anticipated By McQuilkin.

In items 1 to 4 on pages 2 to 3 of the above-identified final Office action, claims 1, 2, 4, 5, 7, and 21-26 have been rejected as being anticipated by U.S. Patent No. 5,575,802 to McQuilkin et al. (hereinafter "McQuilkin") under 35 U.S.C. § 102(b).

The Examiner has taken the position that the first hinge 16 of the McQuilkin sterilization clip anticipates the U-shaped bridge in applicants' surgical clip. As discussed in detail below, however, the U-shaped feature disclosed by McQuilkin is not only structurally distinct from applicants' device but is functionally different. Because the elements differ in both structure and function, the rejection should be withdrawn and the rejected claims should be allowed.

Anticipation under 35 U.S.C. § 102(b) requires the presence in a single prior art reference each and every element of a claimed invention arranged as in the claimed invention. See e.g., *Eolas Technologies, Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1335 (Fed. Cir. 2005). Where the elements of a claimed invention are arranged differently or function differently, there is no anticipation. *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick, Co.*, 730 F.2d 1452, 1459 (Fed. Cir. 1984) (lower court erred finding anticipation when it treated "the claims as mere catalogs of separate parts, in disregard of the part-to-part relationship, set forth in the claims and that give the claims their meaning"). To determine whether prior art anticipates an invention, one must identify the elements of the claimed invention, determine their meaning in light of the specifications and prosecution history and identify corresponding elements disclosed in the allegedly anticipatory reference. *Id.*; *SSIH Equipment S.A. v. U.S.I.T.C.*, 718 F.2d 365, 377 (Fed. Cir. 1983) (in determining whether prior art anticipates an invention, court must

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determine what are the elements of a claim and what does the reference disclose). To anticipate a claimed invention, the elements disclosed in a prior art reference must function in substantially the same way to produce substantially the same result as in the claimed invention. *Tate Eng'g v. U.S.*, 477 F.2d 1336, 1342 (Ct. Cl. 1973).

On page 8 of the Examiner's Answer, the Examiner states that "the rubber linings 18 and 19 are not considered part of the arms." This conclusion cannot be supported. (It is also noted that the correct reference numerals for the linings are 18 and 20 and, therefore, the correct numerals will be used hereinafter. These linings 18, 20 are integral to the arms and, therefore, must be considered part of the arms. This is because absence of these linings 18, 20 would entirely render the McQuilkin device non-functional.

This rejection does not take into account both the structural and functional differences between the U-shaped bridge disclosed by applicants and the McQuilkin clip. Claim 1 calls for, *inter alia*, a surgical clip, including:

a bridge connecting first and second arms to form a substantially U-shaped structure; and  
at least one deformable retainer extending past one end of the arms in a direction,  
wherein the retainer has a length in the direction of at least  $\pi$  times the distance between  
the arms when the arms are substantially parallel.

Claim 21 calls for, *inter alia*, a surgical clip, including :

a bridge connecting the first and second arms to form a substantially U-shaped structure  
with the first and second arms being substantially parallel to one another; and

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at least one deformable retainer extending past one end of the arms in a direction, the retainer having a length in the direction equal to a multiple of a distance between the arms, the multiple being greater than 2.5.

Claim 22 calls for, *inter alia*, a surgical clip, including:

a bridge connecting first and second arms to form a substantially U-shaped structure; and

at least one deformable retainer extending from one of said arms and having a deformable portion, said deformable portion of said retainer having a length of at least approximately  $\pi$  times the distance between said arms when said arms are substantially parallel.

Simply put, claims 1, 21, and 22 provide that “a bridge connects said first and second arms to form a substantially U-shaped structure.” By definition and, **more importantly, as described and defined clearly in the specification**, a “U-shaped structure” as defined herein requires some positive distance between the two arms of the U-shape. If there is no distance between the arms, then the overall shape cannot be considered “U-shaped” as defined in the claims. Pursuant to *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 45 USPQ2d 1429 (Fed. Cir. 1998), applicants became their own lexicographers and defined the meaning of “U-shaped” as used in the claims. Specifically, on pages 7 to 8 and on pages 23 to 24, applicants defined the phrase to be first and second arms with a bridge portion therebetween and the arms “defin[ing] an open space 230 between them.” Page 23, line 25. It is this definition that must be used by the Examiner and not the suggested impermissible variation where “U-shaped” is being defined as two arms having absolutely no distance therebetween.

The two McQuilkin jaws 12, 14 are hinged to move with respect to one another between an unclamped position (where the jaws 12, 14 are at an angle to one another as shown in FIG. 1) and a clamped or ligating position (FIG. 20 – the ligating position being defines as having the

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two inside opposing surfaces of the jaws 12, 14 *rest against one another* when the jaws 12, 14 are parallel – a configuration that is entirely opposite to the required structure of the instant claims. Because *McQuilkin requires there to be no distance between the jaws 12, 14 to function as intended*, the McQuilkin clip cannot be considered U-shaped and, accordingly, cannot anticipate either of claims 1, 21, or 22. The configuration disclosed by McQuilkin is not structurally equivalent. Simply put, McQuilkin is not U-shaped when the clip is functional and applicants' device is U-shaped.

To make up for the clear deficiency of McQuilkin to be U-shaped, the Examiner argues that the silicon rubber lining disclosed in 18, 20 can be disregarded as being separate from the jaws 12, 14. McQuilkin, however, provides no support for the Examiner's argument. More importantly, if this supposed conclusion were accurate, then such a modified device would render the McQuilkin clip entirely ineffective for its intended purpose. McQuilkin explicitly recites features of the linings 18, 20 at:

Col. 1, lines 20 to 21, 37 to 38, 55 to 59;  
Col. 2, lines 15-21, 52 to 67;  
Col. 3, lines 1 to 4, 11, 40 to 41; and  
Col. 4, lines 5 to 11, 20 and 39.

In each and every described configuration, the McQuilkin liner 18, 20 is disclosed as being non-removably fixed to the upper and/or lower jaws 12, 14. Even though made of different material, it is never separate from the jaws 12, 14. A solitary disclosure of *how* the liner 18, 20 *contacts* the jaws 12, 14 is found at col. 2, lines 56 to 58 – “a suitable adhesive is used to fix the lining to the jaws 12, 14.” (Emphasis added by applicants.) Because the lining 18, 20 is always fixed to



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the jaws 12, 14, the combination of the lining and jaw 12, 14 and the 14, 20 function as a single *integral* part.

Indeed McQuilkin cannot achieve its intended clipping purpose – sterilization -- as set forth in each and every one of its 10 claims, unless the distance between the jaws 12, 14, 18, 20 is equal to zero. Any positive distance between the jaws would not allow the clip to achieve its function of isolating and occluding the vessel(s) clamped between the jaws. McQuilkin uses the liners 18, 20 to *absolutely ensure that there is no separating distance between the jaws 12, 14* when the jaws 12, 14 are in the closed position. Because the distance between:

the two surfaces of the liner 18, 20 (col. 1, lines 37 to 38); or

one surface of the jaws 12 or 14 and one surface of the liner 18 or 20 (col. 2, lines 59 to 67),

*always touch one another*, the McQuilkin clip can never be considered as having a functional U-shaped structure as set forth and defined in the present application.

To function for its intended purpose, i.e. providing for “sexual sterilization”, see e.g., Abstract, col. 1, lines 3 to 6, and each and every Claim 1 to 10, the McQuilkin clip requires direct and unseparated contact between the silicon rubber lining 18, 20 of the jaws 12, 14. FIG. 1 illustrates the clip in the open position prior to use. FIGS. 2 and 3 illustrate the clip in the closed and closed-fastened positions, respectively. The McQuilkin clip functions by clamping either the Fallopian tube or vas deferens in order to effect occlusion. To work at all, the silicon rubber lining 18, 20 of the jaws 12, 14 must be in *direct* contact. In other words the distance between jaws 12, 14 **must be zero**. Therefore, the McQuilkin retainer cannot equate to a retainer with a

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length of greater than 2.5 or  $\pi$  "times the distance between the arms when the arms are substantially parallel" as set forth in claims 1, 21, and 22 (see also claim 17).

When in the non-applied (open) position, the McQuilkin jaws *are not parallel*. The only time they are parallel is when the clip is in the occluding (closed) position and the silicone rubber linings 18, 20 are in direct and unseparated contact. In order to function, therefore, McQuilkin does not and cannot teach two arms having a "distance between the arms when the arms are substantially parallel" to one another as set forth in claims 1, 17, 21, and 22.

The rejection further ignores that the function of applicants' U-shaped bridge is very different from that served by the first hinge 16 in McQuilkin. In the present invention, the U-shaped bridge functions to gather and hold in place plicated tissue for clipping. McQuilkin does not act to plicate tissue, although it does act to occlude Fallopian tubes or vas deferens. Occlusion is not a function of the first hinge 16, but rather of the deformable, silicon, rubber lining 18, 20 integrally and fixedly attached to the jaws of McQuilkin's device. Thus, to the extent that McQuilkin gathers and holds tissue, it is not a function of any shape reflected in McQuilkin, as it is in the present invention, but rather of the material that McQuilkin employs.

With respect to the retainer of the present invention, the Examiner further ignores the language and features of the claims. Claims 1, 21 and 22 disclose a surgical clip with a retainer extending  $\pi$  times, greater than 2.5 times, or  $\pi$  times, the distance between the arms, with the arms substantially parallel to one another. Notwithstanding the error in asserting that there is a functional distance between the arms of the McQuilkin clip, McQuilkin does not disclose a

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retainer extending " $\pi$  [or greater than 2.5] times the distance between the arms when the arms are substantially parallel". Even under the Examiner's mistaken construction, the McQuilkin retainer does not extend the distances set forth in the claims of the present invention. First, the McQuilkin retainer is curved and does not extend in the direction of the jaw. This leads the Examiner to mistake the outer circumference of the retainer, 140, for an extension past the arm in the direction of the extension. The actual distance of the extension, i.e., the extension of the retainer past the jaw is not specifically disclosed but, at a maximum, can be no greater than 4mm (the length L3) but, in function, extends far less because the distance between the hinge 144 and the tooth 150 in the direction is less than 2mm.

Furthermore, the feature that the retainer extends "in a direction" allows the gathering of plicated tissue into the clip, as depicted for example in FIGS. 14 and 17. What the Examiner erroneously considers the "extension" of the retainer in McQuilkin does not function in the same way to achieve the same result because of its curved shape. The McQuilkin clip is used to occlude a discrete vessel, Fallopian tubes, or vas deferens to prevent the curved retainer from compromising its functionality. But the curved McQuilkin retainer would obstruct the gathering of plicated tissue in devices such as the present invention. For these reasons as well, applicants believe claims 1, 21, and 22 are allowable over McQuilkin. Each discloses a retainer extending in a direction and having a greater length than that shown in McQuilkin.

Applicants' dependent claims also present different structural features not disclosed by McQuilkin, thereby rendering the Section 102(b) rejection erroneous.

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For example, claims 2 and 23 of the present invention disclose a surgical clip having a first arm and retainer of lesser thickness. McQuilkin discloses a clip having one arm and a retainer of equal or greater thickness. The rejection of claims 2 and 23 is based not on the thickness of the retainer portion but rather of the hinge that attaches the retainer to the lower jaw 14. Due to the unitary plastic construction of the clip, the hinge is necessarily the thinnest section of the frame. When the structure the Examiner identifies as the retainer itself (L4) is measured, it is apparent that the thickness is, at a minimum, equal to the jaw and significantly thicker elsewhere.

Next, claims 4 and 25 disclose a retainer wherein the retainer has a sharp tip. Although the Examiner contends that McQuilkin discloses a retainer with a sharp tip, simple reference to the features recited dispels such a contention. While reference numerals 150 and 126 indicate teeth used for interlocking the McQuilkin clip, they are not shown or described as having a sharp tip. Thus, it is respectfully believed that the Examiner is simply mistaken.

Similarly, the Examiner errs in arguing that McQuilkin discloses "decouplable" retainers like the present invention does in claims 5 and 26. It is argued, on page 3 of the Final Office Action, that "if one were to disassemble hinge (16)" (emphasis added by applicants), the upper jaw of McQuilkin (12) would decouple from the retainer (140).

First, there is no suggestion anywhere in McQuilkin that the first hinge 16 can be "disassembled" as argued by the Examiner. Indeed, McQuilkin states that:

[i]t is a further object of the present invention to provide sterilization clips which may be manufactured with a frame comprising a single piece of plastics material. (Emphasis added by applicants.)

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But, McQuilkin would entirely lose its intended purpose if so disassembled! Further, given the interlocking tooth mechanism that McQuilkin describes to fasten the upper jaw 12 to the retainer 140, upon the non-suggested "disassembl[y]" of the hinge 16, the jaw 12 would, in fact, detach from 140.

With regard to claims 5 and 26, the Examiner appears to argue (on page 9 of the Examiner's Answer) that there is no disclosure in the specification for the decoupling retainer. Respectfully, FIGS. 21 to 24 clearly disclose such a decoupling retainer 420, 422 and the specification at page 26 more than clearly describes decoupling of the retainers 420, 422. Thus, this argument is erroneous. Further, severing the retainer of McQuilkin would entirely destroy its utilitarian features. And, there is absolutely no disclosure to destroy the retainer in the manner suggested by the Examiner.

For the reasons set forth above, all of which are incorporated herein by reference, claims 7, 24, and 28 of applicants device are not anticipated by McQuilkin. Those claims disclose a surgical clip having two arms, each of which has an associated retainer of approximately the same length thereof and equipped with a sharp tip. McQuilkin does not disclose a retainer with a single associated arm and also does not disclose such a retainer with a sharp tip.

For all of these reasons, claims 1, 21, and 22 are allowable and the rejection under Section 102(b) should be reversed. Claims 1, 21, and 22 are believed to be patentable over McQuilkin. The dependent claims 2, 4, 5, and 7 are believed to be patentable as well in addition to being

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ultimately dependent on claim 1. The dependent claims 23 to 26 are believed to be patentable as well in addition to being ultimately dependent on claim 22.

3. Claims 17 and 18 are Not Anticipated By DiGiovanni

In item 5 on pages 3 to 4 of the above-identified Office action, claims 17 and 18 have been rejected as being fully anticipated by U.S. 4,430,997 to DiGiovanni et al. (hereinafter "DiGiovanni") under 35 U.S.C. § 102(b).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the reference.

DiGiovanni discloses a multiple clip applier used to apply clips like those disclosed in McQuilkin. See, in particular, FIG. 2A of DiGiovanni. Therefore, all of the arguments above with respect to McQuilkin are equally applicable to distinguish DiGiovanni from the present invention and are hereby incorporated herein by reference. It is particularly noted that the DiGiovanni clips have a structure that must function to "ligate a vessel", that are set "about the vessel to be ligated", and/or are "set to ligate the vessel." See DiGiovanni at col. 1, line 15, col. 2 lines 5, 31, and 40 respectively. (Emphasis added by applicants). "Ligation" requires that there exists no distance between the arms of the clip ligating the vessel. Thus, when parallel, the DiGiovanni arms must have zero distance between them in order to effect ligation.

This is not an argument of intended use of the DiGiovanni clip. It is an argument where the structure must, by definition, perform a given function (ligation). It cannot perform another

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function because its structure is such that requires the jaws of the clip to completely touch one another. This is a structure that is entirely different from that described in claims 17 and 18.

For all of these reasons, claims 17 and 18 are allowable and the rejection under §102(b) should be reversed. Claims 17 and 18 are, therefore, believed to be patentable over DiGiovanni.

4. Claims 1, 3 to 6, 21 to 25, and 28 are Not Anticipated By Chen

In items 6 to 7 on page 4 of the above-identified Office action, claims 1, 3 to 6, 21 to 25, and 28 have been rejected as being fully anticipated by U.S. Patent Publication 2004/0104199 A1 to Chen under 35 U.S.C. § 102(e).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the reference.

The Examiner rejected Claims 1, 3 to 6, 21 to 25, and 28 as fully anticipated by Chen. Chen discloses a paper clip formed from repeating rectangular coils of a continuous piece of metal wire. The Examiner's rejection of the present claims is based on his erroneous contention that no structure is given to the word "retainer" in claims 1, 21, or 22 of the present invention. The Examiner therefore argues, in essence, that Chen may be uncoiled to produce applicants' clips and therefore Chen anticipates. Because applicants believe that the present application recites sufficient structure, and for the other reasons discussed below, Chen does not anticipate the claims of the present invention.

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Specifically, Claim 1 calls for, *inter alia*, a surgical clip, including:

at least one deformable retainer extending past one end of the arms in a direction, wherein the retainer has a length in the direction of at least  $\pi$  times the distance between the arms when the arms are substantially parallel.

Next, claim 21 calls for, *inter alia*, a surgical clip, including:

at least one deformable retainer extending past one end of said arms in a direction, said retainer having a length in said direction equal to a multiple of a distance between said arms, the multiple being greater than 2.5.

Finally, claim 22 calls for, *inter alia*, a surgical clip, including:

at least one deformable retainer extending from one of the arms and having a deformable portion, the deformable portion of the retainer having a length of at least approximately  $\pi$  times the distance between the arms when the arms are substantially parallel.

Each of these claims provides a structure of "at least one deformable retainer" with other features. Chen neither discloses nor suggests the structure of a deformable retainer extending "past one end of the arms" as set forth in claims 1 or 21. Nor does Chen disclose or suggest a retainer having a deformable portion with a length  $\pi$  times the distance between the arms when the arms are substantially parallel as set forth in claims 1 or 22.

The Examiner errs in arguing that because the entirety of the Chen paper clip is capable of being bent out of a shape that it is required to maintain to function, it is deformable. It is with this function-destroying argument that the Examiner arrives to a comparison of the entire length of the paper clip to the retainer of claims 1, 21, and 22. This is tantamount to arguing:

because Chen's paper clip is made of a deformable wire, it could, therefore, be uncoiled and reshaped into an entirely different and non-suggested or anticipated structure. Thus, Chen anticipates any possible structure into which the wire could be formed.



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Such argument is specious at best. The claims of the present invention disclose a first and second arm as well as a bridge and reflect the structure discussed above. The retainer extends from one of the arms or past one end of the arms. Thus, the retainer of the present invention is not comparable to a portion of the Chen paper clip. Further, there is absolutely no suggestion in Chen to deform the paper clip in the way suggested by the Examiner. Indeed, to do as Examiner suggests and uncoil the Chen paper clip would defeat the primary object of Chen:

“to form a plurality of overlapping clipping portions”, see Chen at paragraph [0005]; or in order to allow for the clipping together of “different groups of documents” using the same clip, see Chen at paragraph [0004].

Chen discloses a paper clip made up of repeating, rectangular clipping portions formed from a continuous wire. If, as Examiner proposes, the clip is unwound, the Chen “retainer” would cease to function as it is supposed to function in Chen – as an integral element connecting one clipping portion to the next.

As with the Examiner’s construction of McQuilkin, the Examiner errs in rejecting claim 1 of the present invention over Chen. Chen does not disclose a retainer extending in a direction and having “a length in said direction of at least approximately  $\pi$  times the distance between the arms when the arms are substantially parallel.” Emphasis added by applicants. Chen’s drawings, in fact, disclose a retainer having a length equal to (or slightly more when the retainer is curved as in FIG. 3) the distance between the arms – not “ $\pi$  times” greater. Indeed for Chen to have a structure that functions as a clip, the length of the retainer must equal or, at most, slightly exceed, when curved, the distance between the clipping arms. For the same reasons, Chen does not

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anticipate claim 21 which recites a retainer having a slightly lesser extension – 2.5. Similarly, the Examiner's rejection of claim 22 should be overturned.

In the Examiner's Answer at pages 11 to 12, it is argued that claims 1, 3 to 6, and 21 to 25 do not provide any description to which direction the retainer is extending. This argument entirely disregards features clearly set forth in the claims directly relating to these attributes. For example, in claim 1, the retainer is different from the first arm, the second arm, and the bridge. The retainer "extend[s] past one end of the arm in a direction" and the "length in said direction" is Pi times the distance between the arms when the arms are substantially parallel to one another. Similarly, the retainer of claim 21 "extend[s] past one end of said arms in a direction" and the retainer of claim 22 "extend[s] from one of said arms."

As with McQuilkin, the **dependent** claims rejected by Examiner also include features not contained in Chen and, therefore, should be independently allowed.

For example, Chen fails to disclose a retainer having a sharp tip as set forth in claims 3, 4, 24 and 25 of the present invention. While the Examiner contends that Chen discloses a sharp tipped retainer, he does not identify any disclosure or structure in Chen that reflects his contention.

Nor does Chen disclose decouplable retainers of applicants' device as set forth in claims 5 and 6. Claim 6 reflects the further feature that the retainer is coupled to an arm of the clip using a friction fit. The Examiner's response, that the "retainer *could be* wrapped around either or both arms and be maintained by friction" does not explain how Chen discloses decouplable retainers

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nor any suggestion of a mechanism in Chen allowing for a friction fit. (Emphasis added by applicants.)

Next, claims 23 and 28 disclose a retainer or retainers having lesser thickness than the associated arms. There is no similar disclosure in Chen where there is only disclosed a paper clip made from a wire having a uniform thickness.

Like the rejection of DiGiovanni, the above arguments are not one of intended use of the Chen paper clip. It is an argument where the Chen structure must, by definition, perform a given function. It cannot perform another different function because its structure is such that requires the coiling of the paper clip. This is a structure that is entirely different from that described in claims 17 and 18.

Finally, applicants appreciatively acknowledge the Examiner's statement that claims 8 to 10, 27, and 29 to 31 "would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." In light of the above, applicants respectfully believe that rewriting of these claims is unnecessary at this time.

In view of the foregoing, reconsideration and allowance of claims 1 to 10 and 17, 18, and 21 to 32 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

Applic. No. 10/010,246  
Response Dated August 20, 2007  
Responsive to Final Office Action of January 5, 2005

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If an extension of time for this paper is required, petition for extension is herewith made.

The fee of \$200 for one additional independent claim in excess of 3 is included herewith. Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Mayback & Hoffman, P.A., No. 503,836.

Respectfully submitted,

  
\_\_\_\_\_  
For Applicants

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August 20, 2007

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